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7/8/03 #7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:	Murthi Nanja	§	Art Unit:	2172
Serial No.:	09/778,565	§		
Filed:	February 7, 2001	§	Examiner:	Isaac M. Woo
For:	Aggregating Web Data on Clients and Distributing the Aggregated Data to Wireless Handheld Devices	§	Atty. Docket No.:	ITL.0521US (P10765)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

**PETITION DECIDED BY THE TECHNOLOGY CENTER DIRECTOR
PURSUANT TO M.P.E.P. § 1002.02(c)(3)(g) 37 C.F.R. § 1.181
REFUSAL TO ENTER AN AMENDMENT**

The Examiner has refused to enter amendments that merely incorporate a dependent claim into an independent claim; thus, the amendments do not raise new issues or they put the application in better form for appeal.

Facts Involved

1. On or about May 21, 2003, the Examiner entered a Final Rejection rejecting claims 1-25.
2. On or about June 9, 2003, the Applicant replied to the Final Rejection amending the claims by incorporating the subject matter of a dependent claim into an independent claim.
3. On June 20, 2003, the Examiner entered an Advisory Action refusing to enter the proposed amendments because they raise new issues that would require further consideration and/or search.
4. The amendments do not raise new issues because an independent claim merely incorporates the subject matter of a dependent claim. Thus, further consideration or search is not required. Moreover, the amendments put the application in better form for appeal and/or in condition for allowance.

Date of Deposit: July 8, 2003

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Debra Cutrona
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Points to be Reviewed**1. Refusal to amend claim 1**

The Examiner refused to amend claim 1 because it would "raise new issues that would require further consideration and/or search." See Paper No. 6, page 1. Specifically, the Examiner states that claim 1 recites additional limitations, such as "detecting the occurrence of a predetermined time; "automatically transferring web", and "at the predetermined time". Thus, the amendments require further consideration and search. See Paper No. 6, page 2.

Prior to the current amendment, claim 1 called for aggregating information from two or more websites, and providing the information to a wireless device. Original claim 11 called for detecting the occurrence of a predetermined time and automatically transferring information to a wireless device at the predetermined time. As amended, claim 1 calls for aggregating information from two or more websites, detecting the occurrence of a predetermined time, and automatically transferring information to a wireless device at the predetermined time. Thus, the amendment to claim 1 merely incorporates subject matter from a dependent claim.

Because the Examiner previously considered the limitation set forth in dependent claim 11, no new issues are raised by the present proposed amendment to claim 1. For example, the Examiner finally rejected claims 1-25 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Khan et al. (U.S. Patent No. 6,438,575). With respect to claim 1, the Examiner cited Kahn at Figures 2 and 3; column 9, lines 55-67 to column 10, lines 1-26; column 11, lines 36-64; column 1, lines 43-67 to column 2, lines 1-34. See Paper No. 4, pages 2-3. Further, with respect to claim 11, the Examiner cites Khan at column 2, lines 35-62 and column 11, lines 12-36. See Paper No. 4, page 5. Although the Applicant maintains that Khan does not teach or suggest detecting an occurrence of a predetermined time and automatically transferring information to a wireless device at the predetermined time, the Examiner's reference to Khan has shown that he has considered the very point that he now claims raises new issues. Thus, when conducting a search, the Examiner would have had to consider a device including the limitations set forth in each of the dependent claims including dependent claim 11. As such, no new issues have been raised by the present proposed amendment to claim 1.

2. Refusal to amend claim 12

The Examiner has refused to amend claim 12 because it raises new issues that would require further consideration and/or search. *See* Paper No. 6, page 1. Specifically, the refusal to amend claim 12 is the same as the refusal to amend claim 1. Thus, for the reasons set forth above, the Applicant respectfully traverses the Examiner's refusal to enter the amendment to claim 12. Specifically, the present proposed amendment of claim 12 merely incorporates the subject matter set forth in dependent claim 22, which indirectly depends from claim 12. Thus, no new issues have been raised by the proposed amendment to claim 12. As such, the refusal is an error and should be reversed.

3. Refusal to amend claim 23

With respect to claim 23, the Examiner has refused to enter the proposed amendment because it would raise new issues that would require further consideration and/or search. *See* Paper No. 6, page 1. As amended, claim 23 incorporates subject matter that is substantially the same as the subject matter set forth in claims 11 and 22. The Examiner rejected all of the claims on the same ground. Thus, it is respectfully submitted that he would have necessarily had to consider the subject matter sought to be incorporated into claim 23. Thus, for the same reasons presented above, it is respectfully submitted that the proposed amendment to claim 23 would not raise new issues because the subject matter of the amendment was already considered with respect to other claims.

Requested Action

The proposed amendments do not raise new issues that would require further search and/or consideration because a dependent claim or the subject matter of a dependent claim is merely incorporated into an independent claim. Moreover, for the same reasons, the amendments put the claims in condition for allowance and/or in better form for appeal. Thus, it is respectfully requested that the amendments to claims 1, 12 and 23 be entered.

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Legal Argument

The Examiner erred in refusing to enter amendments to claims 1, 12 and 23 proposed by the Applicant in its Reply to Final Rejection. *See* Paper No. 5. Although an amendment after final rejection is not necessarily a matter of right, an amendment that places the application in condition for allowance or in better form for appeal should be entered. *See* M.P.E.P. § 714.12 Amendments After Final Rejection or Action. When evaluating whether an amendment will place the application in condition for allowance or in better form for appeal, the amendment should be given sufficient consideration and the refusal to enter the proposed amendment should not be arbitrary. *See* M.P.E.P. § 714.13 Amendments After Final Rejection or Action, Procedure Followed. Further, when the amendment removes issues for appeal or places the application in condition for allowance, a showing as required under 37 C.F.R. § 1.116(c) is not required. *See* M.P.E.P. § 714.13.

Because the proposed amendments to claims 1, 12 and 23 merely incorporate the subject matter of a dependent claim, no new issues are created and/or issues are removed for appeal. In fact, the Examiner rejected all of the claims over one reference, which suggests that the subject matter of each of the claims has already been considered and no new issues are raised. As such, the Examiner's refusal to enter the proposed amendments is arbitrary and not based upon sufficient consideration. Thus, the amendments to claims 1, 12 and 23 should be entered as requested.

Fee

A petition pursuant to Rule 1.181 does not have a fee expressly provided for in Rule 1.17. The Commissioner is authorized to charge and/or credit any additional fees to Deposit Account No. 20-1504 (TTL.0521US).


Statement that the Petition is Timely Filed

The complained about action took place on June 20, 2003. Thus, this matter has been addressed within two months of the complained about action.

Respectfully submitted,

Date: July 8, 2003




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09/778,565

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MESSAGE:

Attorney Docket No.: ITL0521US (P10765)

RLS/dlc

Applicant: MURTHI NANJA
Serial No.: 09/778,565
Filing Date: February 7, 2001
Title: AGGREGATING WEB DATA ON CLIENTS AND DISTRIBUTING THE AGGREGATED
DATA TO WIRELESS HANDHELD DEVICES

1. Petition Decided by the Technology Center Director Pursuant to M.P.E.P. § 1002.02(c)(3)(g) 37 C.F.R. § 1.181 Refusal to Enter an Amendment; and
2. Fax Coversheet

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